REMARKS

Claims 32-38 and 43-47 are pending in this application. Claims 26-31, 39-42, and 48-56 are being canceled, without prejudice or disclaimer, to expedite prosecution.

102(e) Rejection of Claims 50, 51, and 54

The Examiner rejected claims 50, 51, and 54 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,252,511 to Mondshine et al. ("*Mondshine et al.*"). Claims 50, 51, and 54 have been canceled. Thus, this rejection is moot.

103(a) Rejections of Claims 26-31, 39-42, 48, 49, and 52

The Examiner also rejected claims 26, 28, 30, 31, 39, 41, 42, and 52 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,768,164 to Hollon, Jr. ("*Hollon*") in view of *Mondshine et al.* The Examiner also rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Hollon*, *Mondshine et al.*, and U.S. Patent No. 6,385,466 to Hirai et al. Also, the Examiner rejected claims 27 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Hollon*, *Mondshine et al.*, and U.S. Patent No. 6,286,109 to Pirdy. Furthermore, the Examiner rejected claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Hollon*, *Mondshine et al.*, and U.S. Patent No. 5,710,576 to Nishiyama et al.

Claims 26-31, 39-42, 48, 49, and 52 have been canceled. Thus, these rejections are moot.

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103(a) Rejection of Claims 32-35 and 43-46

The Examiner also rejected claims 32-35 and 43-46 under 35 U.S.C. § 103(a) as being unpatentable over *Hollon* in view of U.S. Patent No. 6,633,930 to Sonehara et al. ("*Sonehara et al.*"). Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness under §103(a), each of three requirements must be met. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," to combine references or modify a reference. MPEP § 2143 (8th ed. Rev. Feb. 2003). Second, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* Moreover, both of these requirements must "be found in the prior art, not in applicant's disclosure." *Id.* Third, the reference or references, taken alone or in combination, must disclose or suggest every element recited in the claims. *Id.*

Claims 32 and 43

Applicant respectfully traverses the Examiner's rejection of claims 32-35 and 43-46, as unpatentable over *Hollon* in view of *Sonehara et al.*, at least because these references fail to teach or suggest each and every element of independent claim 32, from which claims 33-35 depend, and these references also fail to teach or suggest each and every element of independent claim 43, from which claims 44-46 depend. For example, *Hollon* fails to teach or suggest a "main display," a "sub-display provided ... at

a position where the sub-display is externally visible when the main display is in a

closed position," and either

> "display control means which displays a name of an application program **to be started in response to the event generated** by the jog device on the sub-display **in one of a power-off state, a sleeping state, and a main display off state**" (emphasis added), as recited in claim 32; or
>
> "displaying a name of an application program **to be started in response to the event generated** by the jog device on the sub-display **in one of a power-off state, a sleeping state, and a main display off state**" (emphasis added), as recited in claim 43.

> Instead, *Hollon* teaches:
>
> When a user of portable computer 10 desires to utilize a particular application program on spontaneous use display 39, the user locates the active window of the application program at section 21 of display 20 (shown in FIG. 1). The user then puts portable computer 10 into an inactive mode and closes the cover. (Col. 2, line 65 to col. 3, line 3; emphasis added)

The "application program" of *Hollon* is not "an application program to be started

in response to the event generated by the jog device" (emphasis added), as required by

each of independent claims 32 and 43. Rather, the "application program" of *Hollon* has

already been started in an "active window" before the application program can be

utilized on "spontaneous use display 39."

Sonehara et al. does not make up for the deficiencies of *Hollon* because

Sonehara et al. only discloses a jog device and its associated hardware and software.

Sonehara et al. fails to teach "display control means which displays a name of an

application program **to be started in response to the event generated** by the jog

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device on the sub-display **in one of a power-off state, a sleeping state, and a main display off state**" (emphasis added), as recited in claim 32, or "displaying a name of an application program **to be started in response to the event generated** by the jog device on the sub-display **in one of a power-off state, a sleeping state, and a main display off state**" (emphasis added), as recited in claim 43.

Thus, since *Hollon* and *Sonehara et al.* do not teach or suggest each and every element of independent claim 32 or independent claim 43, claims 32 and 43, and claims 33-35 and 44-46 dependent therefrom, respectively, are allowable over *Hollon* and *Sonehara et al.*

103(a) Rejection of Claims 36-38, 47, 53, 55, and 56

The Examiner also rejected claims 36-38, 47, 53, 55, and 56 under 35 U.S.C. § 103(a) as being unpatentable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 36-38

Claims 36-38 are allowable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* for at least the reason that these claims depend from claim 32, which is allowable over *Hollon* and *Sonehara et al.* for at least the reasons explained above.

Mondshine et al. fails to make up for the deficiencies of *Hollon* and *Sonehara et al.* because *Mondshine et al.* also does not teach or suggest "display control means which displays a name of an application program to be started in response to the event generated by the jog device on the sub-display in one of a power-off state, a sleeping state, and a main display off state," as recited in claim 32.

Claim 47

Claim 47 is allowable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* for at least the reason that this claim depends from claim 43, which is allowable over *Hollon* and *Sonehara et al.* for at least the reasons explained above in reference to the rejection of claim 43.

Mondshine et al. does not make up for the deficiencies of *Hollon* and *Sonehara et al.* because *Mondshine et al.* also fails to teach or suggest "displaying a name of an application program to be started in response to the event generated by the jog device on the sub-display in one of a power-off state, a sleeping state, and a main display off state," as recited in claim 43.

Claims 53, 55, and 56

As noted above, claims 53, 55, and 56 have been canceled. Thus, this rejection is moot as applied to claims 53, 55, and 56.
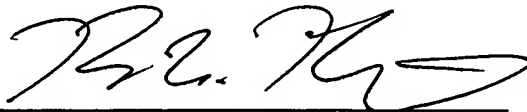
<u>CONCLUSION</u>

In view of the foregoing amendments and remarks, Applicant respectfully

requests reconsideration and reexamination of this application and the timely allowance

of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 17, 2005   By:_____

Reece Nienstadt
Reg. No. 52,072

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